

Appln. No. 09/842,341
Amendment dated February 1, 2005
Reply to Office Action of November 1, 2004

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

The November 1, 2004 Office Action and the Examiner's comments have been carefully considered. In response, the title of the invention is amended, claims are cancelled and added, and remarks are set forth below in a sincere effort to place the present application in form for allowance. The amendments are supported by the application as originally filed. Therefore, no new matter is added.

PRIORITY

In the Office Action the Examiner acknowledges Applicants' claim for foreign priority but indicates that he has not received the certified copies of the corresponding priority applications. In response, Applicants respectfully state that the certified priority documents were filed with the original application papers. Submitted herewith is a return receipt postcard stamped by the Patent Office indicating that the Patent Office did in fact receive the two certified priority documents. In view of the foregoing, Applicants respectfully request that the Examiner acknowledge receipt of the certified priority documents in the next Patent Office communication.

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TITLE OF THE INVENTION

In the Office Action the title of the invention is objected to as not being descriptive. In response, the title of the invention is amended to be more clearly indicative of the invention to which the claims are directed. In view of the amendment of the title, reconsideration and withdrawal of the objection to the title are respectfully requested.

If, even in view of the amendment of the title, the Examiner maintains his objection, the Examiner is respectfully requested to propose a new title in the next Patent Office communication for Applicants' consideration.

REJECTION UNDER 35 USC 112, SECOND PARAGRAPH

In the Office Action claims 1-14 are rejected under the second paragraph of 35 USC 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, claims 1-14 are cancelled, thereby rendering the rejection under 35 USC 112 moot.

PRIOR ART REJECTIONS

In the Office Action claims 1-10 are rejected under 35 USC 102(e) as being anticipated by USP 6,655,284 (Hoshii et al.).

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Claims 11-14 are rejected under 35 USC 103 as being unpatentable over Hoshii et al. and further in view of USP 6,747,752 (Farago).

In response, claims 1-14 are cancelled and new claims 15-22 are added. Independent claim 15 is based on cancelled claims 6 and 7, claim 16 corresponds to cancelled claim 8, claims 17 and 18 include limitations from claims 9 and 10 respectively, and claim 19 includes a new limitation which is supported by the original application at page 17, line 19 - page 18, line 2, inter alia. Claims 20-22 include limitations from claims 11-13 respectively.

The present claimed invention as defined by new claim 15 is directed to a method for producing a print on which both a visible image of image data based on an image captured by a customer and specific information are printed. The method includes the steps of extracting the specific information from a memory section in which a plurality of specific information are stored, irrespective of the image captured by the customer, printing the specific information onto a part of the print based on the extracted specific information, and printing the visual image onto the print wherein a plurality of the specific information are stored in the memory section in such a manner that a predetermined degree of priority is determined in advance

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and the extracted specific information is extracted according to the degree of priority.

Claim 15 is characterized in that a plurality of specific information are stored in the memory section in such a manner that a predetermined degree of priority is determined in advance and the extracted specific information is extracted according to the degree of priority.

In item #8 on page 5 of the Office Action, the Examiner states that Hoshii discloses every feature recited in claim 6, and further teaches, with regard to claim 7, that "a plurality of the specific information sets are stored in the memory section in such manner that a priority degree or an order of each of the specific information sets is determined in advance (col. 4, lines 33-44)."

In response, Applicants respectfully state that Hoshii et al. do not at all discuss a degree of priority at column 4, lines 33-44, nor in any other portion of the patent. Column 4, lines 33-46 of Hoshii et al. recite:

A storage unit 15 stores image data of a plurality of kinds of advertisement information (to be simply referred to as images of advertisement information" hereinafter), and temporarily stores a photo image read from the memory card loaded into the recording medium unit insert mechanism 10.

An image processing algorithm unit 16 executes an image processing algorithm for a photo image and an advertisement image. Note that the image processing algorithm can be

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implemented by software by the storage unit 15 and the controller 7 that executes a program in place of a hardware image processing algorithm unit 16, when an arithmetic processor that constructs the control module of the controller 7 has high processing speed.

As is evident from the foregoing excerpt from Hoshii et al., it is clear that the reference does not disclose, teach or suggest the limitation, as now recited in new claim 15, that a plurality of the specific information are stored in the memory section in such a manner that a predetermined degree of priority is determined in advance and the extracted specific information is extracted according to the degree of priority (see claim 1, lines 11-15).

None of the other references close the gap between the present claimed invention as defined by claim 15 and Hoshii et al. Therefore, claim 15 is patentable over Hoshii and all of the other references of record when taken either alone under 35 USC 102 or in combination under 35 USC 103.

Claims 16-19 which are either directly or indirectly dependent on claim 15 are patentable over the cited references in view of their dependence on claim 15 and because the references do not disclose, teach or suggest each of the limitations set forth in claims 16-19.

Moreover, claim 19 recites that the degree of priority is determined according to fluctuations in advertising fees.

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Neither Hoshii et al. nor any other of the references of record disclose, teach or suggest that the degree of priority is determined corresponding to fluctuations in advertising fees.

Claim 20 is directed to a method for producing a print on which both a visual image of the image data based on a captured image by a customer and specific information are printed. The method includes the steps of generating a random number, extracting the specific information from a memory section in which a plurality of specific information are stored based on the random number and irrespective of the image captured by the customer. The method also includes printing the specific information onto a part of the print based on the extracted specific information, and printing the visual image onto the print.

Claim 20 recites that a random number is generated. In the Office Action the Examiner acknowledges that Hoshii et al. do not teach extracting a specific information set based on a random number (see item #10 on pages 6-7 of the Office Action). However, in order to bridge the gap between claim 11 and Hoshii et al., the Examiner relies upon Farago.

In the Office Action the Examiner states, with reference to Fig. 3 and col. 4, lines 9-14 of Farago, that "Farago teaches of extracting the specific information based on the random number,"

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and that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of extracting of Hoshii for extracting the specific information set based on the random number as taught by Farago."

Applicants respectfully point out that Farago does not disclose, teach or suggest extracting the specific information from a memory section in which a plurality of specific information are stored based on the random number irrespective of the image captured by the customer.

All of the value added portions taught by Fig. 3, and col. 4, lines 9-14 of Farago are related to products in a fixed demonstration part 4. In other words, Farago does not disclose extracting the value added portions irrespective of the products in the fixed demonstration part 4.

Accordingly, a person of ordinary skill in the art at the time the invention was made would not have arrived at the present claimed invention as defined by new claim 20 based on the combination of references because the references do not disclose, teach or suggest the feature of extracting the specific information irrespective of the image captured by the customer as recited in claim 20, lines 6-9.

In view of the foregoing, claim 20 is patentable over the cited references under 35 USC 102 as well as 35 USC 103.

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Claims 21 and 22 are dependent on claim 20 and are patentable over the cited references in view of their dependence on claim 20 and because the references do not disclose, teach or suggest each of the limitations set forth in claims 21 and 22.

In view of all of the foregoing, claims 15-22 are in form for immediate allowance, which action is earnestly solicited.

It is respectfully believed that no additional fees are due for the presentation of new claims 15-22. However, if any additional fees are due, please charge our Deposit Account No. 06-1378 for such sum.

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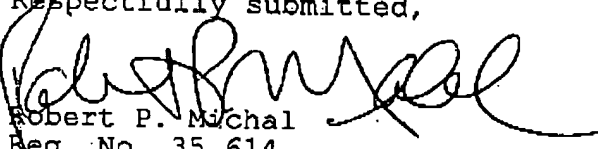
Entry of this Amendment, allowance of the claims and the passing of this application to issue are respectfully solicited.

If the Examiner disagrees with any of the foregoing, the Examiner is respectfully requested to point out where there is support for a contrary view.

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If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



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Atty. Docket # 01255/LH

THE PATENT OFFICE ACKNOWLEDGES RECEIPT OF:

New appln: Transm. ltr (dupl.); spec, claims,
Abstract (78 pages); Declaration; Assignment
w/record. cover sheet;
9 sheets formal drawings (Figs. 1-9);
2 cert. priority document;
Change of Correspondence Address (with bar code)
\$710. ck. #82135 & \$40. ck #82136.

W. SATAKE et al

LH:bv

Priority: MAY 8.
Mailed: April 25, 2001
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